

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD Q. POYNTER and ALBERT D. BAILEY

Appeal No. 2000-1715
Application No. 08/925,053

ON BRIEF

Before COHEN, ABRAMS, and STAAB, Administrative Patent Judges.
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 13-15. Claims 1-7, 9 and 10 have been canceled, and claims 8, 11 and 12 have been allowed.

We REVERSE.

BACKGROUND

The appellants' invention relates to a compressible syringe. The claims on appeal have been reproduced in the appendix to the appellants' Brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

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|---------|-----------|---------------|
| Drewe | 3,473,524 | Oct. 21, 1969 |
| Sneider | 4,262,669 | Apr. 21, 1981 |

Claims 13-15 stand rejected under 35 U.S.C. § 103 as being unpatentable over Drewe in view of Sneider.¹

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the Answer (Paper No. 18) for the examiner's complete reasoning in support of the rejection, and to the Brief (Paper No. 17) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

¹A rejection of claims 13-15 under 35 U.S.C. § 112, second paragraph, was withdrawn by the examiner in the Answer (page 4).

As manifested in claim 13, the appellants' invention is directed to a syringe comprising a bellows having a longitudinal axis and including a plurality of bellows rings each including first and second frusto-conical walls that converge at an apex. The invention requires, inter alia, that the syringe have a forward portion and a rearward portion and that the diameters of the bellows rings increase successively from the rearward portion to the forward portion. According to the final paragraph of the claim this, and the other required features, "cause the bellows rings to collapse by inversion upon collapsing force being applied to said bellows rings."

It is the examiner's view, with respect to claim 13, that all of the required subject matter is disclosed by Drewe, except for the increasing diameter of the bellows rings from the rearward portion to the forward portion of the syringe and the included angle of the first bellows ring being greater than that of the second. It is the examiner's position, however, that modifying Drewe by orienting the bellows rings such that they increase in diameter from the rear to the front, which also would meet the terms of the claim regarding the included angles, constitutes a mere reversal of parts which would have been obvious to one of ordinary skill in the art. He further points out that such a bellows orientation is taught by Sneider (Answer, page 4). The appellants take issue with this conclusion.

The rejection is under 35 U.S.C. § 103. The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for

example, In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a prima facie case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellants' disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988).

Drewe discloses a syringe comprising a plurality of bellows rings that are arranged so that their diameters successively decrease from the rearward to the forward portions of the syringe, which is the opposite of the requirements of the appellants' claim 13. The Drewe syringe has two liquid-holding sections 11 and a third independently collapsible and expandable section 12, and teaches that the force necessary to collapse section 12 is less than that to collapse sections 11. The purpose of this construction is to permit the syringe to accomplish an "aspiration test" after insertion of the needle and prior to injection of the medication in sections 11 (column 3, line 48 et seq.).

Sneider discloses a bellows-type syringe in which the bellows rings successively increase in diameter from the rearward portion to the forward portion (Figure 1) which, the examiner apparently believes, confirms his opinion that it would have been obvious to reverse the parts in the Drewe syringe (Answer, page 4). However, from our perspective, the issue is not so simple. As noted above, the Drewe syringe injects a substance when it is collapsed. However, its rearmost bellows ring, which is larger than the others, allows it to perform the additional function of aspirating prior to the injecting step, and this operation requires that the largest bellows ring be “independently collapsible” and to respond to a pressure that is less than that required to collapse the other rings (column 3, lines 48-71). In this regard, the reference states that the factors affecting the operation of the bellows rings include the external diameter (column 3, line 6).

The mere fact that the prior art structure could be modified does not make such a modification obvious unless the prior art suggests the desirability of doing so. See, In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). In the present case, modifying the Drewe syringe by reversing the direction in which the diameters decrease would constitute a significant reconstruction of the device which might jeopardize the aspirating function, that is, to cause it not to be operable for its intended purpose. In our opinion, this would operate as a disincentive to one of ordinary skill in the art to do so. In this regard, while the examiner apparently finds suggestion to do so in Sneider’s statement

that his syringe provides virtually complete expulsion of the fluid contents, it seems to us that one of ordinary skill in the art would recognize that this is an important goal of virtually any syringe, and it would appear from Figure 2 that complete collapse also will occur in the Drewe syringe. In view of the foregoing, we fail to perceive any teaching, suggestion or incentive in either reference which would have led one of ordinary skill in the art to modify the Drewe construction so as to reverse the taper of the diameters of the bellows rings. This being the case, it is our conclusion that the combined teachings of the two applied references fail to establish a prima facie case of obviousness with regard to the subject matter recited in claim 13, and we will not sustain the rejection of this claim.

Independent claims 14 and 15 contain the same limitation and therefore, for the same reason, we also will not sustain the standing rejections of those claims.

SUMMARY

The rejection is not sustained.

The decision of the examiner is reversed.

REVERSED

IRWIN CHARLES COHEN
Administrative Patent Judge

NEAL E. ABRAMS
Administrative Patent Judge

LAWRENCE J. STAAB
Administrative Patent Judge

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